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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,920	03/29/2001	Yoshiaki Komatsu	108631	4360

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EXAMINER

NGUYEN, KEVIN M

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/819,920

Applicant(s)

KOMATSU, YOSHIAKI

Examiner

Kevin M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is made in response to applicant's amendment filed on April 18, 2005. Claim 11 is cancelled, claims 1, 8, 10 are amended, and claims 1-10 and 12-14 are currently pending in the application. An action follows below:
2. The amendment and the argument of the applicant filed April 18, 2005 with respect to the amended claims 1 and 8 have been considered and are not persuasive, see pages 7- 9, necessitated the new ground(s) of rejection presented in this Office action.
3. The amendment to the specification filed April 18, 2005 is acknowledged.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imai et al (previously cited) in view of Fleck (newly cited, US 6,689,965).
6. As to claims 1 and 8 (currently revised), Imai et al teach an apparatus associated with a program, the apparatus comprising: a recording unit (fig. 1) including
  - a. A recording mode selecting device is defined by a recognizing section 10 is an input by pen of the user (a recording position designating portion, see detail

in fig. 2, col. 6, lines 27-35) for designating a certain position in an input area 230 (see detail in fig. 5).

b. A recording switch is defined by a sound outputs at a recording start signal T1 and a recording end signal T2 of sound data in response to a switching of the switch (see detail in fig. 7).

c. A coordinates on data detecting device is defined by see detail in fig. 2.

d. A designed coordinate data storing device is defined by a first table stores the coordinate data (see detail in fig. 3, col. 6, lines 37-46).

e. A written information inputting device includes a tip for inputting written information by a certain position in the input area 230 (see detail of first table B in fig. 4, col. 7, lines 16-25). An easer stroke (see detail of first table A in fig. 4, col. 7, lines 1-7).

f. The recorded sound data at the time when the specified pen stroke was input is played back, as shown in Fig. 8b (col. 8, line 64 through col. 9, line 2).

Accordingly, Imai et al teach all the subject matter claimed except for the use of the coordinate input area (fig. 4 of Imai et al) instead of the coordinate input areas 103 including certain positions is within certain areas.

However, the coordinate input area (fig. 4 of Imai et al) and the coordinate input areas 103 including different menu sub areas 105-155 (fig. 8, see details in col. 3, lines 50-59 of Fleck) have been recognized in the art as equivalents as evidenced by Fleck. Fleck teaches the benefit of using these elements to allow the user for varying different control or graphical parameters of the system (col. 3, lines 58-59).

Therefore, it would have been obvious to one of ordinary skill in the art to replace the coordinate input area in Imai et al with the coordinate input areas 103 including different menu sub areas 105-155 in view of fig. 8 of Fleck, because this would provide the operator with a physical or mechanical cue on the surface of the tablet so that the operator or user can feel when the pointer is over or proximate menu area 103 as taught by Fleck (col. 9, lines 50-55).

Moreover, where the claimed differences involve substitution of interchangeable equivalents and the reason for the selection of one equivalent for another was not to solve an existent problem such substitution has been judicially determined to have been obvious. See In re Ruff, 118 USPQ 343 (CCPA 1958).

7. As to claims 2 and 9, Imai et al teach an apparatus associated with a program, the apparatus comprising: FIG. 2 shows the operation of the system in the present embodiment during recording. First, the continuous data recording section 1 records sound data in the form of audio signals during a conference. The input event storage section 3 comprises a first table for linking input events with time data and a second table for linking locations on a display with entries in the first table (col. 6, lines 20-26).

8. As to claims 3 and 10, Imai et al teach an apparatus associated with a program, the apparatus comprising: the recorded sound data can be partially played back and this playback can be carried out while recording in the conference, and an action for this playback is also construed as one of input events in a broader sense. When playing back a desired part of the sound data, a user will specify displayed characters and figures, saying "let's consider by playing back this part", and this specified spot is

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entered in the first table at portion "C" in FIG. 4 by combining the time data when the spot is specified with an identifier indicating that the input is "playback." (col. 7, lines 26-35).

9. As to claim 4, Imai et al teach the "normal stroke" mode when the posture of the pen is normal, and the "eraser" mode when the pen is upside down (col. 7, lines 7-10).

10. As to claims 5 and 6, Imai et al teach an apparatus associated with a program, the apparatus comprising: when the pen is pressed down and a stroke is made, the current time and a sequence of coordinate points showing the stroke of the pen are recorded in the first table (operation A). At the same time, a linkage between the entry in the first table and the displayed location on the screen is written into the second table (operation C). The event inputted by the pen at this time is displayed on the screen and is sent to the displaying section 8 at the time of playback to display on the screen (operation B) (col. 6, lines 27-35).

11. As to claim 7, Imai et al teach when the pen is pressed down and a stroke is made, the current time and a sequence of coordinate points showing the stroke of the pen are recorded in the first table (operation A). Thus, the digitizer comprises inherent the switch on/off.

12. As to claim 12, Imai et al teach an apparatus associated with a program, the apparatus comprising: when a virtual "eraser" for erasing the stroke as shown in FIG. 4 is used, an identifier of "eraser" is entered in the attribute field in portion "A" of the first table. Whether a sequence of coordinate points detected as a stroke has been made as a "normal stroke" or by "eraser" can be determined by a button to be pressed on the

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pen indicating each mode, or a sensor which recognizes its posture on the pen (col. 7, lines 1-7). It is obvious to provide to erases the sound data if all o the stroke is erased.

13. As to claims 13 and 14, Imai et al teach when the pen is pressed down and a stroke is made, the current time and a sequence of coordinate points showing the stroke of the pen are recorded in the first table (operation A). Thus, the recording switch is disposed on the digitizer.

### ***Response to Arguments***

14. Applicant's arguments filed 04/18/2005 have been fully considered but they are not persuasive.

15. In response to applicant's argument that claims 1 and 8 recite "a recording switch that operates in response to the recording position designating portion indicating that the certain position is within a certain area of an input area of a recording mode selecting device."

Examiner is not convinced by Applicant's argument because Imai et al expressly teach when the pen is pressed down (recording switching as claimed) and a stroke is made, the current time and a sequence of coordinate points showing the stroke of the pen are recorded in the first tablet (operation A) (fig. 2, see details col. 6, lines 28-35), as modified by Fleck, teaches the claims 1 and 8 limitation of "*a certain potion is within a certain area of an input area*" corresponding to "the coordinate input areas 103 including different menu sub areas 105-155" (fig. 8, see details in col. 3, line 50-59).

For these reasons, the rejections based on Imai et al and Fleck have been maintained.

***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M. Nguyen whose telephone number is 571-272-7697. The examiner can normally be reached on MON-THU from 8:00-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick N. Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for



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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

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<http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the

Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197

(toll-free).

Kevin M. Nguyen  
Patent Examiner  
Art Unit 2674

KMN  
June 23, 2005

  
**XIAO WU**  
**PRIMARY EXAMINER**